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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/455,805	12/07/1999	SUSAN D. WOOLF	03797.78802	5591
28319	7590	05/15/2007	EXAMINER	
BANNER & WITCOFF, LTD. ATTORNEYS FOR CLIENT NOS. 003797 & 013797 1100 13th STREET, N.W. SUITE 1200 WASHINGTON, DC 20005-4051			NGUYEN, MAIKHANH	
ART UNIT		PAPER NUMBER		
2176				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/455,805	WOOLF ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Maikhahan Nguyen	2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### **Status**

- 1) Responsive to communication(s) filed on 06 March 2007.
- 2a) This action is **FINAL**.                                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### **Disposition of Claims**

- 4) Claim(s) 1,3-6,8-10,12-16 and 18-33 is/are pending in the application.
- 4a) Of the above claim(s) 29 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1, 3-6, 8-10, 12-16, 18-28, and 30-33 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### **Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### **Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### **Attachment(s)**

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)  
 Paper No(s)/Mail Date 2/23/06 and 6/7/06.
- 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application
- 6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

1. This action is responsive to communications: Election/Restriction filed 03/06/2007 to the original application filed 12/07/1999.

Claims 1, 3-6, 8-10, 12-16, 18-28, and 30-33 are presented for examination. Claim 29 has been withdrawn. Claims 2, 7, 11, and 17 have been canceled. Claims 1, 3-6, 8-10, 16, 18-23, and 27-28 have been amended. Claims 31-33 have been added. Claims 1, 10, 16, and 29 are independent claims.

Applicant is required to cancel non-elected claim 29 in the next response to this Office action.

## **Election/Restrictions**

2. Applicant's election without traverse of group I (claims 1, 3-6, 8-10, 12-16, 18-28, and 30-33) in the reply filed on 03/06/2007 is acknowledged.

### Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

*(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.*

*This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).*

4. Claims 1, 5-6, 8-10, 12-16, 19-28, 30, and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Levine et al.** (US 5680636, issued 10/1997) in view of **Cassorla et al.** (US 5146552, issued 02/1992, as cited in the Applicant's IDS filed 10/24/2002).

#### As to claim 1:

Levine teaches a computer-implemented method of annotating pages of an electronic document independently of the contents of the document (e.g., *see fig. 1 and the accompanying text, beginning at col. 9, line 13*), comprising:

- displaying a page of the electronic document on a computer display device using a document browser that permits a user to move forward and backward among a plurality of document pages (e.g., *the display screen and/or have several pages ... scrolling from top to bottom of a single page or sequentially from one page to succeeding or preceding pages; col. 20, lines 44-48*);

- detecting a selection of an annotation mode that permits the user to annotate the currently displayed document page (e.g., *the user simply places one end of the stylus on the table position which corresponds to the position of the typing cursor in the displayed view of the document being annotated and move the stylus end across the surface of the tablet to the desired position; col.4, lines 18-39 and col.23, lines 5-19*);
- receiving annotation stroke input from a user input device indicating that the user has move the user input device for a continuous distance about a stroke location on the currently displayed document page (e.g., *when either end of stylus 14 is positioned near the area on the tablet 16 which corresponds to the edge of the document being annotated, a cursor 100 depicting a close-fisted hand is displayed at the respective position at the edge of the document ...to scroll a page of the document or multiple document itself from one page to another, line byline, at a rate in a manner dictated by the user” “touching and moving” the stylus along the corresponding tablet area; col.20, lines 44-57*); and
- storing annotation stroke data based on the received annotation stroke input, the annotation stroke data comprising data responding to the stroke location and the move or the user input device (e.g., *all annotations of a document during an annotation session are sequentially recorded in the relative time ... All keyboard*

*strokes are recorded in a “keyboard” file ... Each of these files contains the respective type of data input during the annotation session and time marks or other indications of relative time of occurrence of the input of that data; col.6, lines 19-50).*

Levine does not specifically teach “*the annotation stroke is stored in an annotation file associated with the user, the annotation file store separate from the electronic document.*”

Cassorla teaches the annotation stroke is stored in an annotation file associated with the user (e.g., *Once the reader has completed a note, the invention adds topic, line number, author identification, date and time information to the text of the note; col.5, lines 8-30*), the annotation file store separate from the electronic document (e.g., *an electronically published document to create notes, bookmarks or annotations and relate them to a particular location in the document ... Annotations stored separately from the originally published document; see Abstract and col.2, lines 16-55*).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Levine with Cassorla because Cassorla’s teaching would have produced various effects or functions of the stylus without explicit associated commands or without knowingly placing the stylus in respective modes. That is, the stylus may be operated at any one time to produce the various functions without an explicit user request

to change modes and without particular commands of operation to a processor. Such a seemingly modeless, commandless format makes the system easy to understand and thus readily usable by even the most non-computer oriented, untrained user. Hence, the system is a very "user-friendly" system.

**As to claim 5:**

Levine teaches the stored annotation stroke data corresponds to an erase highlighting that erases previously annotated areas of the currently displayed document page (*col.2, lines 36-59; col.5, line 46-col.6, line 10*).

**As to claim 6:**

Levine teaches the user input device a stylus in a tablet computer system (*e.g., an electronic stylus and electronic tablet; col.1, lines 52-67*).

**As to claim 8:**

Levine teaches updating the computer display device to display a different page of the currently displayed document (*e.g., the processor 22 changes the currently displayed document 73 of working program from text mode to graphic mode ... changes the currently displayed document from a dark background with light print to a light background with dark print; col.11, lines 39-54*); retrieving previously stored annotation stroke data associated with different page (*col.5, lines 51-55 and col.20, lines 18-43*);

and displaying annotations corresponding to the previous stored annotation stroke data on the computer display device superimposed over the different page (*see Abstract*).

**As to claim 9:**

Levine teaches detecting a title change event in the document browser and, in response thereto, locating a second annotation file corresponding to the different document page (*col.19, line 58-col.20, line 11*).

**As to claim 21:**

Levine teaches the annotation stroke data is stored in a data structure (*col.6, lines 19-29 and col.20, lines 17-43*).

**As to claim 22:**

Levine teaches the annotation stroke data comprise a stroke width and coordinates indicating a trajectory of the stroke (*col.6, lines 30-50 and col.22, lines 39-59*).

**As to claim 23:**

Levine teaches annotations are stored as bitmap image (*e.g., an annotatable bit map image; see Abstract*).

**As to claim 30:**

Cassorla teaches the annotation file contains a user identifier associated with the user. (e.g., *Once the reader has completed a note, the invention adds topic, line number, author identification, date and time information to the text of the note; col.5, lines 8-30*).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Levine with Cassorla because Cassorla's teaching would have produced various effects or functions of the stylus without explicit associated commands or without knowingly placing the stylus in respective modes. That is, the stylus may be operated at any one time to produce the various functions without an explicit user request to change modes and without particular commands of operation to a processor. Such a seemingly modeless, commandless format makes the system easy to understand and thus readily usable by even the most non-computer oriented, untrained user. Hence, the system is a very "user-friendly" system.

**As to claim 3<sup>3</sup>:**

Levine teaches the annotation stroke data corresponds to movement of a stylus across the display between a stylus down event (e.g., *stylus and down*) and a stylus up event (e.g., *stylus end up*) [col.22, lines 1-19].

**As to claim 10:**

Note the rejection of claim 1 above, except claim 10 is a system claim and claim 10 is a method claim. It is noted that claim 10 does not require "*detecting a selection of an annotation mode that permits the user to annotate the currently displayed document page; and receiving annotation stroke input from a user input device indicating that the user has move the user input device for a continuous distance about a stroke location on the currently displayed document page.*"

**As to claim 12 and 13:**

Refer to the discussion of claims 3 and 5 above, respectively, for rejection.

**As to claim 14:**

Levine teaches a flat panel display, and wherein the computer input device comprises a stylus (*col.6, lines 30-50 and col.9, lines 24-40*).

**As to claim 15:**

Levine teaches the computer software retrieves, upon detecting a title change event, previously stored annotations associated with a different document page (*col.19, line 58-col.20, line 11*) and displays the previously stored annotations on the different document page (*col.20, lines 16-57*).

**As to claim 24:**

Levine teaches annotation mode selection menu (*e.g., a pop-up menu is displayed ... the user may select; col.5, lines 8-12*).

**As to claims 25 and 26:**

Note to the discussion of claims 21 and 23 above, respectively, for rejections.

**As to claim 16:**

Note the rejection of claim 1 above. Claim 16 includes the same limitations as in claim 1, except claim 16 is a computer-readable storage medium claim and claim 10 is a method claim.

**As to claim 19:**

Refer to the discussion of claim 9 above for rejection.

**As to claim 20:**

Levine teaches in response to detecting that the user has moved to a different page of the currently displayed document (*col.8, lines 6-23*), retrieving previously stored annotation stroke data associated with different page (*col.5, lines 51-55 and col.20, lines 18-43*); and displaying annotations corresponding to the previous stored annotation stroke data on the computer display device superimposed over the different page (*see Abstract*).

**As to claims 27 and 28:**

Refer to the discussion of claims 21 and 23 above, respectively, for rejections.

5. Claims 3-4, 18, and 31-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Levine et al.** in view of **Cassorla et al.** as applied to claims 1 and 16 above, and further in view of **Carlenton** (US 5920694, Date of Patent: 07/6/1999).

**As to claim 3:**

The combination of Levine and Cassorla does not specifically teach "*the stored annotation stroke data corresponds to a translucent highlight that does not completely obscure the annotated portions of the currently displayed document page.*"

Carlenton teaches the stored annotation stroke data corresponds to a translucent highlight that does not completely obscure the annotated portions of the currently displayed document page (*see Abstract; col.12, lines 26-66 and see figs.17-22*).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Carlenton with Levine as modified by Cassorla because Carlenton's teaching would have produced various effects or functions of the stylus without explicit associated commands or without knowingly placing the stylus in respective modes.

**As to claim 4:**

The combination of Levine and Cassorla does not specifically teach “*displaying the translucent highlight on the computer display device, the displaying comprising blending pixels from the currently displayed document with a translucent color to produce a translucent annotation.*”

Carlenton teaches displaying the translucent highlight on the computer display device, the displaying comprising blending pixels from the currently displayed document with a translucent color to produce a translucent annotation (*col.14, lines 1-25*).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Carlenton with Levine as modified by Cassorla because Carlenton’s teaching would have produced various effects or functions of the stylus without explicit associated commands or without knowingly placing the stylus in respective modes.

**As to claim 18:**

Refer to the discussion of claim 3 above for rejection. Additionally, Carlenton teaches the translucent annotation is generated by blending pixels from the currently displayed document with a highlighting pixel color (*col.14, lines 1-25*).

**As to claim 31:**

The combination of Levine and Cassorla does not specifically teach “*access permissions on the annotation file are set to allow the user access to the annotations while denying access to certain other users.*”

Carleton teaches access permissions on the annotation file are set to allow the user access to the annotations while denying access to certain other users (*col.15, lines 36-43*).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Carlenton with Levine as modified by Cassorla because Carlenton’s teaching would have produced various effects or functions of the stylus without explicit associated commands or without knowingly placing the stylus in respective modes.

**As to claim 32:**

The combination of Levine and Cassorla does not specifically teach “*execution of an alpha blending function.*”

Carleton teaches execution of an alpha blending function (*col.13, line 11-col.14, line 25*).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Carlenton with Levine as modified by Cassorla because

Carlenton's teaching would have produced various effects or functions of the stylus without explicit associated commands or without knowingly placing the stylus in respective modes.

### **Response to Arguments**

6. Applicant's arguments filed 08/23/2006 have been fully considered but they are not persuasive.

#### **Regarding independent claims 1, 10, and 29**

Applicant argues in substance that Alexandria does not teach "*storing annotation stroke data based on the received annotation stroke input ... wherein the annotation filed associated with the user*" [Remarks, page 9].

In response, Applicant's arguments are substantially directed to the amended subject matter. The amended subject matter is addressed above with respect to the discussion of independent claim 1.

#### **Regarding dependent claims**

Applicant did not provide arguments in substance regarding claims except for citing the dependencies

## Conclusion

7. The prior art made of record, listed on PTO 892 provided to Applicant is considered to have relevancy to the claimed invention. Applicant should review each identified reference carefully before responding to this office action to properly advance the case in light of the prior art.
  
8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

### Contact information

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maikhanh Nguyen whose telephone number is (571) 272-4093. The examiner can normally be reached on Monday - Friday from 9:00am – 5:30 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached at (571) 272-4136. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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